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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,113	12/29/2000	Tomoko Terakado	208366US6 CONT	6754

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EXAMINER

SAJOUS, WESNER

ART UNIT	PAPER NUMBER
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2676

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,113

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Remarks

This communication is responsive to the amendment and response filed on July 3, 2003. In this response, claims 35-36, 58-59, 72-73, 85-86, and 97-98 are canceled without disclaimer and claims 33, 39-57, 60-71, 74-84, 87-96, and 99-108 are amended. As a result, claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 are currently pending in this application.

Response to Arguments

1. Applicant's arguments with respect to claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-34, 37-39, 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (Darbee), Pat. No. 6130726 in view of Fajkowski, Pat. No. 5905246.

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Considering **claims 33-34**, Darbee, at figs. 1-2, discloses a control device (10) which controls, by transmitting a control signal (e.g., a *IR or RF transmitter*, see *abstract*), an electric apparatus (e.g., a *consumer electronic device or a TV set*, see *abstract*) including an extraction unit (e.g., a *tuner/receiver which is typical in most television set*) and an electric apparatus transmitting unit (e.g., a *conventional IR transmitter of a TV set that operates in conjunction with a remote control*, see *col. 4, lines 20-25*), the electric apparatus transmitting unit for transmitting additional information (e.g., *program guide or advertisement*, see *abstract and col. 4, lines 33-36*) extracted by the extracting unit to a receiver (34, *fig. 2*), that receives information transmitted via a transmission medium (e.g., *an antenna or satellite*), comprising:

A transmitting unit (35) ... electric apparatus; the receiver (34) for receiving additional information (e.g., *advertising or program guide*, *col. 4, lines 33-36*) transmitted by the electric apparatus (e.g., the TV set); an output means (e.g., *items 18, or 20 or 22 or 24 or 25 of fig. 6 and/or fig. 2, items 38 and 28*) for outputting the additional information received by the receiver to a display device (14); a memory (e.g., *item 36 or 40*) for storing at least a portion of said additional information (e.g., *detail information about the current program on the channel {cols. 9-10, lines 65-2}, or detail view information about a movie {col. 14, lines 51-61}*); wherein the additional information include advertisement information (see *col. 4, lines 33-36, and col. 13, lines 5-13*) included in the information received by the electric apparatus.

It is noted that Darbee fails to teach coupon information is transferred from the first memory to a second memory when the user selects the coupon information, and deleting the information stored in the memory.

Fajkowski in a similar art teaches transferring coupon information from the first memory to a second memory when the user selects the coupon information, and

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deleting the information stored in the memory. See col. 6, lines 39-59 together with col. 13, lines 37-66, and col. 15, lines 11-12.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the features of Darbee to include the transfer of coupons records from one storage to another (*e.g., one card to another, see col. 13, lines 37-66*), as taught by Fajkowski; in order to provide a system that allow the consumer or user to instantly receive credit for rebates, while quickly and efficiently supplying the manufacturer with both the demographic data and stimulation power the rebate is intended to provide. See Fajkowski's col. 5, lines 61-65.

In **claim 37**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

As per **claim 38**, the claimed "selecting unit for selecting information...wherein the memory is configured to store the information selected by the selection unit" is met by the functions performed by item 28 of fig. 2 in Darbee's.

Regarding **claim 39**, it is noted that all the elements recited in claim 39, including the second storing unit the second selecting unit, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Darbee, which communicates information from and to the remote controller 10, for these components are conventional elements included in a television system.

As per **claim 41**, the claimed "second electric apparatus is a personal computer, ...accesses a server based on information transmitted from the control device" would have been obvious over Darbee's col. 4, lines 50-56, since the system can access the Internet via a modem (see col. 4, lines 30-33).

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In **claims 42 and 44**, the claimed “notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device” is met by item 14 of fig. 1.

Re **claim 43**, the claimed “control device instructs the electric apparatus to transmit the additional information” is characterized by the function of item 28 of fig. 2.

As per **claims 45 and 46**, the claimed “output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward” would have obvious the system of Darbee, since it enables the user to view program guide, identifying PPV information (see fig. 12) select information pertaining to specific genres or categories (see fig. 32) and to retrieve the selected category (*see col. 6, lines 38-41*) transmitted from the television set. See col. 2, lines 2, lines 6-67, col. 3, line 31 to col. 4, line 5, and col. 9, lines 58-65.

Claim 47 recites features equivalent to claim 33; it is, therefore, rejected for the same reasons and rationale set forth for claim 33.

Claim 48 is a computer program substantially performing the same method as claim 33; it is, therefore, rejected by the same rationale as claim 33.

The invention of **claim 49**, although slightly different, it recites features capable of performing the same function as claim 33. As the various features of claim 33 have been shown to be obvious over the combined teaching of Darbee and Fajkowski, it is readily apparent that the apparatus disclosed by the prior art performs the recited underlying functions, because in Darbee, the remote controller 10 communicates bi-directionally with a television system to transmit signals to and from the other. Hence the television set incorporates the second receiving unit, and it is able to perform

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operation in accordance with the control signal from the remote controller (10).

Therefore, the limitations recited in claim 49 are rejected under the same rationale as claim 33.

Re **claims 50-51**, the claimed "electric apparatus is a personal computer; a television receiver" is obviously met by col. 4, lines 50-56, and col. 4, lines 30-33.

The invention of **claim 53**, although slightly different, it recites features equivalent to claim 49. As such, the limitations of claim 53 are rejected for the same reasons and rationale as claim 49, and incorporated herein.

The invention of **claim 54**, although slightly different, it recites performing functions equivalent to claim 53 and is similarly rejected.

The invention of **claim 55**, although slightly different, it recites performing functions equivalent to claim 48 and is similarly rejected.

3. **Claims 56-57, 60-71, 74-84, 87-96, 99-108** are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Fajkowski and further in view of Kishtaka (6084643).

As per **claims 56-57, 61**, the combination of Darbee and Fajkowski render obvious most claimed features of the invention, as recited in claims 33-34 above, however, it is noted that the combination of Darbee and Fajkowski fail to particularly suggest an IC card as a detachable storing means.

However, Takahashi, in the same field of endeavor, discloses a system including means for selecting information from the additional information received by the receiving means (fig. 3, item 6); and a detachable storing means for storing the information

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selected by the selection unit, --wherein the detachable storing means is an IC card (as characterized by the function of item 41 of fig. 8). It must be understood that storing means 41 could be apart from the receiver, (as is well known in the art) and could be provided to interface with the remote key for storing the user's favorite EPG or program advertisement or all other information communicated to the receiver. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been motivated to incorporate the features of Darbee and Fajkowski together with Takahashi, wherein an IC card as a detachable storing means is provided, in order to limit the amount of time taken to retrieve program information stored by the user (col. 2, lines 5-15).

In **claim 60**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

Regarding **claim 62**, it is noted that all the elements recited in claim 39, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Darbee, which communicates information from and to the remote controller 10, for these components are conventional elements included in a television system.

As per **claim 64**, the claimed "second electric apparatus is a personal computer, ... accesses a server based on information transmitted from the control device" is obviously met by Darbee's col. 4, lines 50-56, since the system can access the Internet via a modem (see col. 4, lines 30-33).

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In **claims 65 and 67**, the claimed “notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device” is met by item 14 of fig. 1.

As per **claims 68-69**, the claimed “output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward” is equivalently met by the system of Darbee, since it enables the user to view program guide, identifying PPV information (see fig. 12) select information pertaining to specific genres or categories (see fig. 32) and to retrieve the selected category (see *col. 6, lines 38-41*) transmitted from the television set. See for example fig. 7, and col. 2, lines 2, lines 6-67, col. 3, line 31 to col. 4, line 5, and col. 9, lines 58-65 in Darbee.

The invention of **claims 70-71, 74-84, 87-96, and 99-108**, although slightly different, they recite the underlying features of claims 56-69, respectively. As the various features of claims 56-58, and 60-69 have been shown to be obvious in view of the combined teachings of Darbee, Fajkowski and Kishtaka, it is readily apparent that the apparatus disclosed by the prior art perform the recited underlying functions. As such, the limitations recited in claims **70-71, 74-84, 87-96, and 99-108** are rejected for the same reasons and rationale given above for claims 56-69. It is noted that since the coupon card suggested in Fajkowski have storage capability to keep coupon records, and it is detached from the main components of the system, it is construed as an IC card, as called for in claim 83.

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4. **Claims 40, 52, and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Fajkowski as applied to claim 33 above, and further in view of Hirose.

Considering **claims 40, 52**, Darbee and Fajkowski render obvious most claimed features of the invention but they fail to suggest that the second electronic apparatus is a recording apparatus performing recording reservation or a computer accesses a server based on the information transmitted from the control device.

Nonetheless, Hirose at fig. 1 illustrates a recording medium 7 as one of a plurality of electronic devices receiving information transmitted from a broadcasting station. Such recording medium is shown interfacing with a receiver. Such receiver is noted to be capable of receiving cable television broadcasting which could be used with a remote controller for transmitting signal to the receiver. Hirose also shows that a personal computer may be used to receive the information via a local area network. It is to be appreciated that computer, by means of the LAN, is able to access a server as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings suggested by Darbee and Fajkowski to include the features taught by Hirose, in order to enhance the flexibility of the system.

Claim 63 recites the features of claim 40 it is similarly rejected.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art considered pertinent to the Applicants' disclosure are as recited in the PTO-892 form.

Any response to this action should be mailed to:

Box

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, **(for technology center 2600 only)**

Or:

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

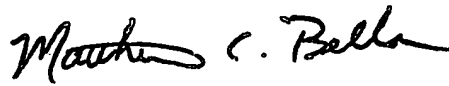
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesner Sajous whose telephone number is (703) 308-5857. The examiner can also be reached on Mondays thru Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number for this group is (703) 308-6606.

WS

3/29/03



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